

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re the Application of:

PAUL A. LUCIW *et al.*

Serial No.: 08/288,336

Group Art Unit: Unassigned

Filed: August 10, 1994

Examiner: Unassigned

For: METHODS FOR DETECTING HUMAN IMMUNODEFICIENCY VIRUS  
NUCLEIC ACID (AS AMENDED)

**DECLARATION IN SUPPORT OF PETITION FOR CORRECTION  
OF INVENTORSHIP PURSUANT TO 37 CFR §1.48(c)**

Hon. Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Sir:

1. We, Paul A. Luciw, Dino Dina, Kathelyn Steimer, Ray S. Pescador, Carlos George-Nascimento, Deborah Parkes, Rob Hallewell, Philip J. Barr and Martha Truett, are the originally named inventors of the parent of the above-captioned patent application, Serial No. 08/107,377 filed on August 17, 1993, which is a divisional of Serial No. 08/083,391, filed June 28, 1993, which is a continuation of Serial No. 07/931,191, filed August 17, 1992, which is a divisional of Serial No. 07/138,894, filed December 24, 1987, which is patented as U.S. Patent No. 5,156,949, which is a continuation-in-part of Serial No. 06/773,447, filed September 6, 1985, which is a continuation-in-part of Serial No. 06/696,534, filed January 30, 1985, which is a continuation-in-part of Serial No. 06/667,501, filed October 31, 1984.

2. We have read the Petition for Correction of Inventorship Pursuant to 37 CFR §1.48(c) ("Petition") and the Statement of Facts therein, attached to this declaration.

3. We verify to the best of our knowledge that the Statement of Facts contained in the Petition is true and accurate.

4. We declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: \_\_\_\_\_

\_\_\_\_\_  
Paul A. Luciw

Date: \_\_\_\_\_

\_\_\_\_\_  
Dino Dina

Date: \_\_\_\_\_

\_\_\_\_\_  
Kathelyn Steimer

Date: \_\_\_\_\_

\_\_\_\_\_  
Ray S. Pescador

Date: \_\_\_\_\_

\_\_\_\_\_  
Carlos George-Nascimento

Date: \_\_\_\_\_

\_\_\_\_\_  
Deborah Parkes

Date: 6<sup>th</sup> September 1995

Robert A. Hallewell  
Rob Hallewell

Date: \_\_\_\_\_

\_\_\_\_\_  
Philip J. Barr

Date: \_\_\_\_\_

\_\_\_\_\_  
Martha Truett

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For: METHODS FOR DETECTING HUMAN IMMUNODEFICIENCY VIRUS  
NUCLEIC ACID (AS AMENDED)

**PETITION FOR CORRECTION OF INVENTORSHIP**  
**PURSUANT TO 37 CFR §1.48(c)**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

This Petition is filed in order to timely correct the inventorship of the above-identified application under 37 CFR §1.48(c). The inventorship is incomplete due to an error made without deceptive intent. This Petition contains a Statement of Facts, the truth of which is verified by each of the original named inventors except Rob Hallewell. A Supplemental Petition for Correction of Inventorship Pursuant to 37 CFR §1.48(c) accompanies this paper and requests that the inventorship be corrected without Hallewell's signature, due to his

refusal to cooperate with applicants. Accompanying the Petition is a Preliminary Amendment, including claims to the subject matter which was invented by the additional inventors; Consent of Assignee to Correction of Inventorship Under 37 CFR §1.48(c); the fee set forth in 37 CFR §1.17(h); and a Declaration and Power of Attorney, signed by each of the added inventors. The Commissioner is hereby authorized to charge any additional fees or credit overpayment to Deposit Account No. 18-0580.

#### Statement of Facts

Information relating to the construction of certain plasmids for expression of heterologous proteins in mammalian cells have been disclosed in the above-captioned patent application and its parent applications ("HIV applications"), tracing back to a continuation-in-part ("CIP") application that was filed on December 24, 1987, Serial No. 07/138,894, now patented as U.S. Patent No. 5,156,949, issued on October 20, 1992. Such information includes, for example, the construction of plasmid pCMV6, and of its parents and derivatives.

However, at the time the CIP application was filed, the emphasis was on identification of DNA sequences obtainable from HIV and the products of expression of such sequences. The claims as originally filed, therefore, reflected such emphasis. The significance of the above-mentioned plasmids was overlooked.

On or about August, 1994, Amy L. Collins, a patent attorney employed by the assignee, Chiron Corporation, reviewed the HIV applications for the first time and discovered the unclaimed plasmids. Following her review, Dr. Collins investigated the significance of the plasmids and inventorship with respect to the plasmids and made the determination that claims to the plasmids should be added in a continuation application and the inventorship corrected to reflect the contribution of Steve Rosenberg, Barbara S.

Chapman, Richard M. Thayer and Nancy L. Haigwood in designing and making the plasmids.

Relief Requested

Accordingly, the Commissioner is respectfully requested to amend the inventorship of the subject application to include Steve Rosenberg, Barbara S. Chapman, Richard M. Thayer and Nancy L. Haigwood. Thus, acceptance of the accompanying documents is earnestly solicited.

Respectfully submitted,

By: \_\_\_\_\_  
Roberta L. Robins  
Registration No. 33,208

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